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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,084	06/24/2004	Hideyuki Tsutsumi	4605-044470	5872

7590 12/13/2005
Richard L Byrne
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/500,084

Applicant(s)

TSUTSUMI ET AL.

Examiner

Patrick D. Niland

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1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 10-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6887930 Uchida et al..

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims overlap in scope such that the ordinary skilled artisan would have practiced the instantly claimed invention from the claims of the patentee, particularly claim 21. It is seen from the enabling specification that the patentee defines the claimed fillers as encompassing those of the instant claims at column 9, lines 62-66. The patented claims encompass the instantly claimed polyamides and amounts thereof.

3. Claims 10-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21, particularly claims 2 and 8 of copending Application No. 10/464474 Oka et al. (this application has been allowed but is not yet published as a patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims overlap in scope such that the ordinary skilled artisan

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would have practiced the instantly claimed invention from the claims of the copending application, particularly claims 2 and 8. It is seen from the enabling specification that the patentee defines the claimed fillers as encompassing those of the instant claims at page 14, lines 8-18. The patented claims encompass the instantly claimed polyamides and amounts thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-26 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5849826 Ogo et al..

Ogo discloses the instantly claimed compositions at the abstract, which reads on the instantly claimed semiaromatic polyamides; column 2, lines 19 through column 15, line 25, which further discloses the instantly claimed semiaromatic polyamides; and column 15, lines 28-46, particularly 30-31 which encompasses the instantly claimed amounts of wollastonite and K titanate fibers. The list of the patentee of fibers is so small that the choice of wollastonite of K titanate fibers is anticipated. The endpoints of the ranges of the amounts of the patentee fall within the scope of the amounts of the instant claims and are therefore anticipatory of the claimed amounts.

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The compositions of Ogo must necessarily and inherently be capable of making reflectors therefrom because they are the same compositions as recited in the instant claims. The compositions of Ogo must necessarily and inherently possess the light reflectance and absorbance properties of the instant claims because they are the same polymers and compositions of the instant claims.

6. Claims 10-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5849826 Ogo et al..

Ogo discloses the instantly claimed compositions at the abstract, which reads on the instantly claimed semiaromatic polyamides; column 2, lines 19 through column 15, line 25, which further discloses the instantly claimed semiaromatic polyamides; and column 15, lines 28-46, particularly 30-31 which encompasses the instantly claimed amounts of wollastonite and K titanate fibers. The list of the patentee of fibers is so small that the choice of wollastonite of K titanate fibers is anticipated. The endpoints of the ranges of the amounts of the patentee fall within the scope of the amounts of the instant claims and are therefore anticipatory of the claimed amounts.

The compositions of Ogo must necessarily and inherently be capable of making reflectors therefrom because they are the same compositions as recited in the instant claims. The compositions of Ogo must necessarily and inherently possess the light reflectance and absorbance properties of the instant claims because they are the same polymers and compositions of the instant claims.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed combinations of ingredients and amounts

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thereof in the compositions of the patentee because they are encompassed by the patentee so thoroughly that the ordinary skilled artisan would have readily envisioned the instantly claimed invention from the disclosure of the patentee and these combinations of ingredients and amounts thereof would have been expected to give the properties of the compositions of the patentee. The instantly claimed absorbance and reflectance properties are inherent to the materials disclosed by the patentee and would have been expected in the final compositions containing these ingredients. There is no showing of unexpected results stemming from the instantly claimed inventions in a manner commensurate in scope with the instant claims and the cited prior art.

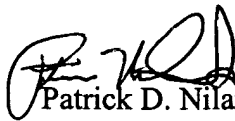
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patrick D. Niland
Primary Examiner
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